

REMARKS

The present application includes claims 10-29. Claims 10-15 have been withdrawn from consideration. Claims 16-29 stand rejected. Claims 16 and 29 have been amended to clarify aspects of the invention.

As an initial matter, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review of the application*, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel **should state all reasons and bases for rejecting claims in the first Office action**. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. **Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved.** A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II) (emphasis added). Claims 16 and 29 were merely amended to clarify aspects of the inventions due to the claim objections noted below. As such, the Applicant assumes, based on the goals of patent examination, that the current Office Action has set forth “all reasons and bases” for rejecting the claims.

The drawings were objected to because four tracking system coil architectures were allegedly not shown. In order to expedite prosecution towards allowance, the Applicant has added Figure 4, which shows four examples of tracking system coil architectures. Figure 4 does not add any new matter, as it is fully supported by the present application at, for example, ¶ [0039].

Claim 16 was objected to because “operable” is not a positive limitation. While the Applicant disagrees that this is an appropriate reason to object to a claim, in order to expedite prosecution towards allowance, the Applicant has amended claim 16, thereby rendering the objection moot.

Claim 17 was objected to because “it is unclear as to what a processing scheme is....” However, processing schemes are discussed in the present application at, for example, ¶¶ [0048] and [0049]. A review of these paragraphs, for example, should dispel any confusion as to the nature of a processing scheme. For at least these reasons, the Applicant respectfully requests reconsideration of this objection.

Claim 29 was objected to because of typographical errors. This claim has been amended to render the objection moot.

Claims 16-22, 24, and 26-27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. 2003/0184285 (“Anderson 285”). “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference.**” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The **identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

The Applicant notes that “[b]ecause the hallmark of anticipation is prior invention, the prior art reference – in order to anticipate under 35 U.S.C. § 102 – must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’ *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).” *Net Moneyin v. Verisign*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). “The test is thus more accurately understood to mean ‘arranged or combined in the same way as in the claim.’” *See id.* at 1370. “[I]t is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.” *See id.* at 1371 (emphasis added).

With those principles in mind, claim 16 recites, in part, “wherein said single tracker electronics sub-system is used with a plurality of tracking system coil architectures.” The Office Action cites Anderson 285 and states that “the tracker electronics could equally function with a plurality of tracking system coil architecture (paras 0094-0098, fig. 6; note whole document).” *See* November 24, 2010 Office Action at page 4.

As shown, the Office Action relies on Anderson 285 at ¶ [0094] – [0098]. However, Anderson 285 at ¶ [0097] merely states that “this device architecture [singular] is advantageously used in connection with a processor to achieve enhanced speed and robustness of tracking coordinates.”

The Office Action does not particularly point to anything in Anderson 285 that expressly or necessarily describes, teaches, or suggests “wherein said single tracker electronics sub-system is used with a plurality of tracking system coil architectures,” as recited in claim 16. Thus, the Office Action has not established that Anderson 285 anticipates any of the pending claims.

Claims 23, 25, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson 285 in view of U.S. 2005/0003757 (“Anderson 757”). The Applicant respectfully traverses these rejections for at least the reasons set forth above.

Additionally, Anderson 757 does not qualify as prior art with respect to the present application. The present application was filed on September 24, 2003, and lists Peter Traneus Anderson as the sole inventor.

Anderson 757 was filed July 1, 2003, and also lists Peter Traneus Anderson as the sole inventor. However, Anderson 757 was published January 6, 2005, well after the filing date of the present application. As such, Anderson 757 does not qualify as prior art under 35 U.S.C. § 102(b).

Further, with respect to 35 U.S.C. § 102(a) and (e), both the present application and Anderson 757 list Peter Traneus Anderson as the inventor. Accordingly, 35 U.S.C. § 102(a) and (e) are inapplicable because the invention was not made by “another.”

Anderson 757 does not qualify as prior art under any section of 35 U.S.C. § 102. For at least these reasons, the Applicant respectfully requests reconsideration of this rejection.

Additionally, the present application, Anderson 285 and Anderson 757 are all assigned to GE Medical Systems Global Technology Company, LLC. Further, Anderson 285 was published after the present application was filed. The subject matter of the present application and Anderson 285 (and Anderson 757) were, at the time the inventions described in the present application were made, owned by the same entity or subject to an obligation to assign thereto. Therefore, under 35 U.S.C. § 103(c), Anderson 285 (as well as Anderson 757) is disqualified as

prior art with respect to 35 U.S.C. § 103. For at least these additional reasons, the Applicant respectfully requests reconsideration of this rejection.

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

The Applicant respectfully requests reconsideration of the claim rejections for at least the reasons discussed above. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account 07-0845.

Respectfully submitted,

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